REMARKS

The Examiner is thanked for the careful examination of the application, and for the interview granted Applicant and his attorney on September 5, 2007. In view of the following remarks, reconsideration and allowance of the pending claims are respectfully requested.

In the Office Action, claims 1-6 and 12-21 were rejected under 35 U.S.C. § 103(a) as obvious over *Ames* (USSIR H1674) and claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ames* in view of *Leak* (U.S. Publication No. 2003/0100878). Applicants gratefully acknowledge the allowability of claims 9, 10 and 11 if rewritten in independent form to include the limitations of the base claim and any intervening claims.

At the interview, the history of the present invention was explained. See the Declaration of Mr. Almberg dated June 29, 2006. In addition, a discussion was had concerning the Examiner's request for more definition of the structure of the joint in the claims. To that point, Applicants' attorney pointed out the structure of the joint already present in the claims, and identified U.S. Patent No. 6,994,698, as well as the decision in *In re Venezia* to support Applicants' position that sufficient structure is already in the claims. Applicants' attorney also requested the Examiner to consider the structure incorporated into the claims via the means plus function elements in claims 20 and 21. No agreement was reached at the interview.

The Examiner acknowledges that the primary reference, *Ames*, does not disclose the claimed minimum average release times at each of the recited angles set forth in independent claims 1, 19 and 20. The Examiner alleges, however, that such features are directed to an "intended use" and that an intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. To support this position, the Examiner relies upon *In re Casey*, 152 USPQ 235 (CCPA 1967). However, the facts in *In re Casey* are the opposite of the present application. In fact, *In re Casey* supports the applicants' position, as will be explained in greater detail hereinafter.

The Examiner must consider the language of the claims:

The Board of Appeals has supported the use of the type of language that the Examiner refuses to consider. In fact, in the Appeal of one of the references applied by the Examiner in this case (Leak et al, now U.S. Patent No. 6,994,698), the Examiner refused to give patentable weight to the Gurley stiffness value in the claims, effectively stating that because of the similarity of materials, the stiffness value would be inherent in the prior art reference. The claim considered in Leak et al is set forth in footnote [1].

This is essentially the same position that the Examiner has taken in the Office Action of the present application. On Appeal of the Leak et al application, the Board stated that, in making an inherency rejection, the Examiner bears the initial burden of making out a *prima facie* case by providing a basis in fact and/or technical reasoning which reasonably supports the position that what is allegedly inherent would necessarily flow from the teachings of the prior art. The Appellants conceded that "the hook material described [in the reference] appears to be like the hook material described on page 18 of appellants' specification", but further argued that this alone is not enough to establish that the applied reference met the claim terms. The Board agreed with the Appellants and reversed the Examiner's rejection. A copy of the decision is submitted herewith.

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[1] 1. A mechanical fastening tab for use on a disposable absorbent product, said fastening tab comprising: a substrate adapted to be joined to said disposable absorbent product; and a first mechanical fastener component joined to said substrate, said first mechanical fastener component being adapted to releasably engage a second mechanical fastener component, said fastening tab having a Gurley stiffness value of less than about 200 milligrams in an area of said fastening tab including said first mechanical fastener component.

As in the Leak et al case, the Examiner in the present situation has not provided a basis in fact and/or technical reasoning which reasonably supports the position that what is allegedly inherent would necessarily flow from the teachings of the prior art. Accordingly, the Examiner's rejection is improper and should be withdrawn.

Applicants have claimed sufficient structure:

All of the claims at issue have sufficient structure. For example, claim 1 in the present application recites structural limitations in the form of conditions that must be fulfilled by the claimed joints. For example, not every joint will meet the claimed release times. Only joints that meet certain structural criteria will satisfy the release times. Accordingly, the test set forth in claim 1 is not dependent upon how the claimed article will be used, it is dependent on whether the claimed article has certain structural features, i.e., sufficient strength to meet the claim requirements.

In addition, the Examiner has completely ignored some of the claims at issue that also have sufficient structure to support the test criteria set forth in the claims. And, the Examiner has not considered any of such structural limitations.

Claim 6:

For example, claim 6 recites that each said belt half is attached to said absorbent structure at said rear end region between said topsheet and said backsheet. Such language is not insignificant. By attaching the belt halves *between* the topsheet and backsheet, the joints can be made stronger than other methods. And, there is no teaching or suggestion of that feature in the applied references.

Claim 7:

Claim 7 depends from claim 6 and further defines each of said joints between each said belt half and said rear end region as comprising two spaced substantially parallel lines of attachment between each said belt half and said backsheet. The Examiner has applied Leak et al. to allegedly teach the parallel lines of attachment. However, the lines in Leak are irrelevant to a joint that is made between the topsheet and the backsheet. Accordingly, the prior art also does not teaching of claim 7 in the applied prior art.

Claim 11:

Claim 11 depends from claims 1, 6, 7, 8, 9, and 10, and further recites that each of said joints between each said belt half and said rear end region further comprises at least one region of bonding between each said belt half and said topsheet. Accordingly, claim 11 thus requires lines of attachment between each said belt half and said backsheet (from claim 7), as well as at least one region of bonding between each said belt half and said topsheet. Therefore, there is bonding between the topsheet and the belt half and the backsheet and the belt half.

Claim 20:

Claim 20 is an independent claim that recites, among other features, "means for joining whereby when each said belt half is subjected to a tension force of 35 N acting along said longitudinal axis of the belt and said longitudinal axis of the belt creates an angle (α) to said transverse axis of said absorbent structure, the following minimum average release times (t) of each said belt half from said absorbent structure are attained..." Under 35 U.S.C. 112, sixth paragraph, a means plus function element should be examined as if it included the structure in the specification that supports the recited function. Accordingly, the means for joining has adequate structure to distinguish itself from the applied prior art.

Claim 21:

Claim 21 recites, among other elements, "means for joining such that when each said belt half is subjected to a tension force of 35 N acting along said longitudinal axis of the belt, said longitudinal axis of the belt creates an angle (α) to said transverse axis of said absorbent structure, and the following minimum average release times (t) of each said belt half from said absorbent structure are attained..." Accordingly, as set forth above, the means for joining has adequate structure to distinguish itself from the applied prior art.

New Claims 22 - 26:

New claims 22 – 26 have been added above. The new claims define combinations that include structural features not found in the applied prior art references. The Examiner is respectfully requested to careful review the structural language in claims 22 – 26 when examining them.

Claims 6, 7, 11, 20 and 21 are just some examples of claims containing structural features that were not properly examined by the Examiner. The Examiner is respectfully requested to carefully examine all of the structural features of all of the pending claims.

The Case Law supports Applicants' Position:

In *In re Casey*, cited by the Examiner, the claim at issue recited a function to be performed by the claimed machine. Although the Examiner refused to give patentable weight to the claimed functions, on appeal the Court held that the Board of Appeals ***properly considered the functional language***, and found that the machine disclosed in the applied reference was also capable of performing the recited functions. *Id.* At 237 – 38. ("The board considered that the structure provided by the reference possessed the capabilities requisite to meet the terms of the claims.") Thus, in *In re Casey,* the functional recitations *were considered.*

Applicants respectfully submit that the claims at issue here recite a structural difference from the prior art. Specifically, as admitted by the Examiner, there is no teaching or suggestion that the joints in *Ames* would meet the test of the claims at issue. ("Even though Ames does not disclose the release times...")

As explained in MPEP 2173.05(g):

> A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.... In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define

> present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

In *In re Venezia*, the Court held that functional recitations directed to an intended assembly of a kit of separate parts were proper limitations to the claims, and must be considered by the Examiner. The claim at issue in *In re Venezia* included many phrases that could be said to be an intended use, including, e.g., "adapted to be fitted", "capable of being assembled", "adapted to be affixed", and "may be slideably positioned". For the convenience of the Examiner, the claim at issue in *In re Venezia* is set forth in an attachment. The emphasis in the claims was inserted by the appellate court. Taking into account the italicized portions of the claim, the Court held that "The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, *if assembled*...Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve."

The claims in the present application similarly recite structural limitations in the form of conditions that must be fulfilled by the claimed joints. For example, only joints that meet certain structural criteria will satisfy the release times. Accordingly, the test set forth in claim 1 is not dependent upon how the claimed article will be used, it is dependent on whether the claimed article has certain structural features, i.e., sufficient strength to meet the claim requirements. Applicants submit that the joints are limited by the requirements of the releasing clause since a relative relationship between release time and release angle is positively recited.

In addition, claim 20 has been amended to recite that each of said joints between each said belt half and said absorbent structure comprises means for joining whereby when each said belt half ... the recited average release times (t) of each said belt half from said absorbent structure are attained. As noted by the Federal Circuit in *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* Applicants respectfully submit that the last clause of independent claim 20 cannot be ignored, since doing so would substantially change the substance of the invention.

For at least the reasons set forth above, Applicants respectfully contend that the Examiner's first position for anticipation, i.e., that the release times are directed to an intended use of the article, must be withdrawn.

The facts Do Not Support An Inherency Rejection:

As a second position, the Examiner maintains that "when the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.02)." However, according to MPEP, section 2112, IV, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." This is the principle discussed above with regard to Leak et al.

Ames does not disclose a specific structure for joining the belt flaps to the rear of the absorbent article. The entire disclosure related thereto, as set forth at col. 17, lines 51-53, is that if the belt flaps 62 and 64 are separate elements joined to the diaper 20, they can be joined "by any means as known in the art." In order to rely on the theory of inherency, it must be shown that the recited conditions *must* be met in each and every instance. MPEP, section 2112, IV. Clearly, the Examiner must recognize that all "means as known in the art" will not *necessarily* satisfy the requirements of the means for joining recited in claims 1, 19 and 20.

Moreover, as set forth in the Declaration Under Rule 1.132 of Mr. Christian Almberg, Paragraphs 3 and 6, Mr. Almberg explains that he and his colleague were able to establish that there ***surprisingly and unexpectedly*** existed a relationship for a given force between the angle at which the force was applied and the time it took for the belt half to become detached from the product. Thus, on the basis of these findings, by ensuring that the joints of a belted absorbent article display the claimed minimum average release times at the various values of the angle α, the claimed absorbent article will be sufficiently reliable in use.

In view of the foregoing remarks, the Examiner is respectfully requested to reconsider and withdraw the outstanding obviousness rejection of claims 1 – 6 and 12 - 20.

Claims 7 and 8:

Claims 7 and 8 have been rejected over *Ames* in view of *Leak*. However, the Examiner relies upon *Leak* only for its alleged teaching of the spaced apart parallel adhesive lines, citing Figure 3. However, the lines 28 of Figure 3 are not adhesive lines, they are ultrasonic bond lines. Furthermore, they do not otherwise overcome the deficiencies set forth above with regard to *Ames*. Accordingly, the rejection of claims 7 and 8 should also be withdrawn.

Conclusion:

In view of the above amendments and remarks, Applicants respectfully submit that the claims of the present application are now in condition for allowance, and an early indication of the same is earnestly solicited.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference would be helpful in resolving any remaining issues pertaining to this application; the Examiner is kindly invited to call the undersigned counsel for Applicants regarding the same.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: October 31, 2007

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte A. TODD LEAK, APIROMRAJ S. ROSLANSKY,
PAUL T. VAN GOMPEL, GEORGIA L. ZEHNER,
EDWARD H. RUSCHER, and YUNG HSIANG HUANG

Appeal No. 2000-0921
Application No. 08/366,090

ON BRIEF

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-54, all the claims pending in the application.

Appellants' invention pertains to a mechanical fastener tab suitable for use on a disposable absorbent product (claims 1-11), wherein the fastening tab comprises a substrate and a first mechanical fastener component[1] joined to the substrate, with the fastening tab having a Gurley stiffness value[2] of less than about 1000 milligrams in the area of the fastening tab that includes the first mechanical fastener component. Appellants' invention also pertains to a disposable product (claims 12-33 and 54) and to a disposable absorbent product (claims 34-53) comprising a mechanical fastening tab as described above. According to appellants, mechanical fastening tabs in accordance with the invention have improved flexibility. A further understanding of the claimed invention can be derived from a reading of exemplary claim 1, which appears in the appendix to appellants' brief.

The references applied in the final rejection are:

Flug et al. (Flug)	5,401,275	Mar. 28, 1995 (filed Sept. 11, 1991)
Roessler et al. (Roessler)	5,176,670	Jan. 5, 1993

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[1] As stated on page 6 of appellants' specification, "a first mechanical fastener component is intended to refer to a material which is adapted to mechanically interlock with a second material. . . . In the illustrated embodiment, the first mechanical fastener component is the hook portion of a hook-and-loop fastener."

[2] Reference is made to pages 17-18 of appellants' specification for an explanation of a suitable technique for determining Gurley stiffness values.

Claims 1-54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roessler in view of Flug. The examiner states (final rejection, page 2):

> Roessler teaches all aspect[s] of the claimed invention except for the specific Gurley stiffness values and substrate overlay of 2%-98%.[3] The Roessler article comprises similar materials as recited in applicants' invention, therefore the Gurley stiffness value is considered to be the same. The Gurley stiffness values recited in applicants' specification, even though performed in a standard testing machine, are considered useless for comparison purposes to the prior art. The Gurley stiffness values can vary depending to sample size and other factors. Even if Roessler stated a Gurley stiffness value, there would be no way to correlate a Roessler value with the claimed values due to different testing procedures.

The examiner further considers (final rejection, page 3) that substrate overlayment of from about 2% to about 98%, as called for in claims 8 and 20, is taught by Flug, and that it would have been obvious in view of this teaching to provide a similar overlayment arrangement in Roessler. The examiner contends (final rejection, page 3) that the rejection is proper because "[a]pplicants have not sufficiently demonstrated that the fastening tab of Roessler will not meet the test value of applicants' invention when tested in accordance to applicants' test method."

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[3] The requirement that the substrate overlays from about 2 to about 98 percent of the planar surface of the first mechanical fastener component is found only in dependent claims 8 and 20.

Discussion

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the examiner. *In re Piasecki,* 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). In making a rejection on the ground that claimed subject matter would inherently be present in the apparatus or process described by a reference, the examiner bears the initial burden of making out a *prima facie* case, as by providing a basis in fact and/or technical reasoning which reasonably supports the position that what is allegedly inherent would necessarily flow from the teachings of the prior art. *See Ex parte Levy,* 17 USPQ2d 1461, 1464 (BPAI 1990) and the cases cited therein. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to a patent. *In re Oetiker,* 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1990).

The main issue in this case is whether Roessler discloses a fastener tab comprising a substrate and a mechanical fastener component wherein the tab has a Gurley stiffness value of less than about 1000 milligrams in the area of the tab that includes the mechanical fastener component. Because we do not agree with the examiner that the claimed invention necessarily flows from the disclosure of Roessler, we will not sustain the examiner's rejection.

The Roessler reference cited by the examiner against the appealed claims discloses, in pertinent part, a mechanical fastener tab 30 of the hook-and-loop type that is suitable for use on a disposable absorbent product. Beginning at column 6, line 29, and continuing to column 9, line 2, Roessler goes into considerable detail concerning the nature of the hook material and the loop material components of the mechanical fastener; however, it is not disputed that Roessler makes no mention whatsoever of the Gurley stiffness value of any of these fastener tab components. Nevertheless, the examiner takes the position that "[[t]he Roessler article comprises similar materials as recited in applicants' invention, therefore the Gurley stiffness value is considered to be the same [as that recited in the claims]" (final rejection, page 2). We surmise from this that the examiner considers the teachings of Roessler at, for example, column 6, line 29, through column 7, line 13, to be of such kind that a fastener tab having the claimed Gurley stiffness value would necessarily flow from making a fastener tab in accordance with these teachings.

In our view, the examiner has provided no basis in fact and/or technical reasoning which reasonably supports the above stated theory of inherency. More particularly, we find appellants' reasoning on pages 3-4 of the brief, which the examiner has not even attempted to refute, as to why the allegedly inherent Gurley stiffness value does *not* necessarily flow from Roessler's teachings to be persuasive. In brief, appellants argue that while the hook material described by Roessler appears to be like the hook material described on page 18 of appellants' specification in connection with example 1, this alone is not enough to establish that the area of the fastener tab in question[4] necessarily has a Gurley stiffness value within the claimed range. In that appellants' specification clearly points out[5] that the Gurley stiffness value at the claimed area is influenced by the physical properties of both the hook material *and* the substrate, appellants' argument is well taken. In addition, and as aptly pointed out by appellants on page 4 of the brief, fastener tabs made using the hook material described on page 18 of appellants' specification, which material is akin to that disclosed in Roessler, may or may not fall within the claimed Gurley stiffness value depending on the characteristics of the substrate. In light of this well reasoned argument, the examiner's unvarnished position to the effect that the claimed subject matter would necessarily result from using Roessler's hook material simply because the hook material of the reference is similar to that used by appellants in making the claimed invention cannot be sustained.

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[4] That is, the area of the fastening tab that includes both the hook material and the substrate.

[5] See, for example, page 7, line 18, through page 8, line 15, and page 9, lines 6-15, of appellants' specification.

We are likewise in agreement with appellants that there is no factual basis for the examiner's contention (final rejection, page 2; answer, pages 3-4) that Gurley stiffness values can vary from sample to sample, such that even if Roessler stated a Gurley stiffness value, there would be no way to correlate a Roessler value with the claimed values. The examiner's contention (final rejection, page 3; answer, page 4) that the burden is on appellants to prove that the fastening tabs of Roessler will not have a Gurley stiffness value within the claimed range is simply wrong. *See In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444.

We have also considered whether Roessler would have rendered obvious a fastener tab having a Gurley stiffness value of less than about 1000 milligrams in the area of the fastening tab that includes the first mechanical fastener component, but find nothing in Roessler that would have suggested the claimed subject matter. Further, the examiner does not contend, and it is not apparent to us, that Flug makes up for the deficiencies of Roessler in this respect.

In view of the foregoing, the examiner's rejection of claims 1-54 as being unpatentable over Roessler in view of Flug cannot be sustained.

The decision of the examiner is therefore reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

Lawrence J. Staab
LAWRENCE J. STAAB
Administrative Patent Judge

John McQuade
JOHN P. McQUADE
Administrative Patent Judge

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 15

Application Number: 08/366,090

Filing Date: December 28, 1994

Appellant(s): Ruscher et al.

Thomas J. Mielke

For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 22, 1997.

Appeal No. 2000 0921
Application No. 08/366,090

KIMBERLY-CLARK WORLDWIDE, INC.
401 NORTH LAKE STREET
NEENAH, WI 54956

EXHIBIT 1

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulting jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cable and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location.*